

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. **020431.0742**

In re Application of:

JAMES M. CRAWFORD, ET AL.

Serial No. **09/675,415**

Filed: **29 SEPTEMBER 2000**

For: **SYSTEM AND METHOD FOR
RENDERING CONTENT ACCORDING
TO AVAILABILITY DATA FOR
ONE OR MORE ITEMS**

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Examiner:

RAQUEL ALVAREZ

Art Unit: **3622**

Confirmation No. **9669**

REPLY BRIEF

MAIL STOP: APPEAL BRIEF - PATENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41(a)(1) in response to the Examiner's Amended Answer mailed 10 October 2007, which was in response to Appellants Amended Appeal Brief filed 10 July 2007.

Appellants filed an Appeal Brief on 27 January 2006 and subsequently submitted amended Appeal Briefs on 25 January 2007 and 10 July 2007 explaining clearly and in detail why the final rejection of Claims 1-43 is improper and the Board should reverse this final rejection. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Appellants Claims are Allowable Over the Cited References

Section 9 of the Examiner's Amended Answer consists entirely of material repeated verbatim from the Final Office Action mailed February 12, 2004. Section 10 of the Examiner's Amended Answer consists entirely of material repeated verbatim from the Examiner's Answer mailed 12 April 2006. Section 10 of the Examiner's Amended Answer consists of four paragraphs. The first, second, and fourth paragraphs consist of material responding to arguments in Appellants Appeal Brief, while the third paragraph consists entirely of material repeated verbatim from the Final Office Action mailed 12 February 2004. Below, Appellants specifically address the material responding to Appellants arguments in the first, second, and fourth paragraphs of Section 10 of the Examiner's Amended Answer.

In the first paragraph of Section 10 of the Examiner's Amended Answer, the Examiner asserts that *Cragun* "clearly teaches that the user request to purchase an item is sent to a server in order for the request to be fulfilled" and that, therefore, *Cragun* discloses ***generating at least one availability request corresponding to the rule and concerning the item***, as recited in Appellants independent claims. Appellants respectfully disagree with the Examiner. In fact, contrary to the Examiner's assertion, *Cragun* does not disclose that "the user request to purchase an item is sent to a server in order for the request to be fulfilled", as asserted by the Examiner. Nowhere does *Cragun* disclose a "user request" or even a "request." *Cragun* discloses only that, when a customer purchases items, information-collection devices collect information on the purchase and communicate the collected information to a computer system that then

analyzes the collected information to identify items missing from the purchase that are members of a class of items represented in the purchase. The identified items become the subject of a sales promotion that an output device communicates to the customer. Nowhere does *Cragun* suggest or even hint that the purchase involves a request that is later fulfilled, as asserted by the examiner. Instead, *Cragun* teaches that the customer's purchase is complete at the time of the transaction.

Moreover, even assuming for the sake of argument that *Cragun* disclosed that "the user request to purchase an item is sent to a server in order for the request to be fulfilled," as the Examiner asserts, such disclosure would still fail to disclose, teach, or suggest **"generating at least one availability request corresponding to the rule and concerning the item"**, as recited in Appellants independent claims. As just an example, such disclosure would still fail to disclose, teach, or even suggest that the user request **corresponds to any rule**, as recited in Appellants independent claims.

Also, in the first paragraph of Section 10 of the Examiner's Amended Answer, the Examiner further asserts that *Cragun* "teaches...that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user", which the Examiner indicates supports the Examiner's assertion that *Cragun* discloses **generating at least one availability request corresponding to the rule and concerning the item**, as recited in Appellants independent claims. Appellants respectfully disagree with the Examiner. Contrary to the Examiner's assertion, *Cragun* does not disclose "that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user." Nowhere does *Cragun* disclose a "user." Therefore, *Cragun* also necessarily fails to disclose, teach, or suggest "the item selected by the user." *Cragun* merely discloses that an item number identifies a product and corresponds to a stock number, inventory number, or the like. Moreover, even assuming for the sake of argument that *Cragun* disclosed "that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory

number for the item selected by the user," as the Examiner asserts, such disclosure would still fail to disclose, teach, or suggest **generating at least one availability request corresponding to the rule and concerning the item**, as recited in Appellants independent claims. As just an example, such disclosure would still fail to disclose, teach, or suggest that the item number, stock number, or inventory number has any bearing whatsoever on *availability*, as recited in Appellants independent claims.

In the second paragraph of Section 10 of the Examiner's Amended Answer, the Examiner asserts that, in *Cragun*, "the items are classified and categorized in classes and according to its class, it recommends the additional items" and that, therefore, *Cragun* discloses *identifying at least one rule within the user-requested content and concerning the item*, as disclosed in Appellants independent claims. Appellants respectfully disagree with the Examiner. For example, because a classification of the items is not user-requested content, such a classification would still fail to disclose, teach, or suggest "*at least one rule within the user-requested content*", as disclosed in Appellants independent claims. Even assuming for the sake of argument that the above classification of items could be properly considered **at least one rule**, as recited in Appellants independent claims, *Cragun* would still fail to disclose, teach, or suggest that the classification of items is somehow **within user-requested content**, as recited in Appellants independent claims.

In the fourth paragraph of Section 10 of the Examiner's Amended Answer, the Examiner asserts that the proposed *Cragun-Linden* combination, on which the Examiner relies to reject Claims 2-3, 16-17, and 31-32, is proper. Appellants respectfully disagree with the Examiner. The Examiner merely states that "*Cragun* can be combined to include the server being a web server as taught by *Linden* because such a modification would provide world access to the system" and that, "[g]iven the web server of *Linden*, one of ordinary skill in the art would have the knowledge or would know that the server being a web server would allow broader use of the system." Such statements fail to demonstrate that *Cragun*, *Linden*, or knowledge that was generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching,

suggestion, or motivation to even attempt—much less actually—combine the references with each other as proposed.

Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”). The Guidelines state, *inter alia*, that the “key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “**the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.**” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on **obviousness cannot be sustained by mere conclusory statements**; instead, there **must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396).

Appellants respectfully submit that the Examiner has failed to provide **clear articulation of the reasons why the Appellants claimed invention would have been obvious**. For example, the Examiner’s unsupported conclusory statements that “such a modification would provide world access to the system”, **does not adequately provide clear articulation of the reasons why Appellants claimed invention would have been obvious**. In fact, Appellants respectfully submit that “provid[ing] world access to the system” of *Cragun*, as asserted by the Examiner, would not have produced predictable results to one of ordinary skill in the art. For example, the system of *Cragun* is designed to operate in a point-of-sale environment, that is, customers purchase at a register or over a telephone. (See *Cragun*, Col. 4, lines 3-8). However, because all of the customers, in the system of *Cragun*, would be calling into or physically present when purchasing, “provid[ing] world access to the system” of *Cragun*, as asserted by the Examiner, would not have produced predictable results to one of ordinary skill in the art. In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious the Appellants claimed invention.

Clear articulation of the reasons why Appellants claimed invention would have been obvious is clearly required by the Guidelines, M.P.E.P., and governing Federal Circuit case law, as discussed at length in Appellants Appeal Brief and reiterated here. The Examiner's failure to provide ***clear articulation of the reasons why Appellants claimed invention would have been obvious*** is fatal to the Examiner's rejections based on the proposed *Cragun-Linden* combination.

For at least these reasons, Appellants claims are patentable over the cited references. Appellants respectfully submit that the rejection of Appellants claims is improper and the Board should reverse this rejection.

CONCLUSION:

Appellants have demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although Appellants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

7 December 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

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